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Docket No. 60,469-037
PA-000.04812-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: O'Donnell, Hugh James, et al.
Serial No.: 09/921,803
Filed: 08/03/2001
Group Art Unit: 3654
Examiner: Kruer, Stefan
Title: ELEVATOR BELT ASSEMBLY WITH
WAXLESS COATING

REPLY BRIEF

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Commissioner for Patents
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Dear Sir:

This is in reply to the Examiner's Answer mailed on April 2, 2008.

The Examiner basically has not provided any basis for justifying the proposed combination of the *Wilcox* and *Harper* references. The Examiner has not been able to refute that the proposed combination would be directly contrary to the express teachings of the *Wilcox* reference, would remove an intended feature from the teachings of that reference, would prevent the arrangement of the *Wilcox* reference from achieving its intended result and that it fails to provide any benefit to the arrangement of the *Wilcox* reference. Further, the Examiner has not stated anything that indicates that even if the proposed combination could be made, that it would result in the claimed invention.

Appellant has already explained why it is not possible to make the proposed combination of the *Wilcox* and *Harper* references. Rather than reiterate Appellant's arguments and without having to address every point made by the Examiner with which Appellant disagrees, Appellant wishes to

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state that Appellant disagrees with every conclusion drawn by the Examiner and with every statement made by the Examiner to the extent that any statement is not based exactly upon what is stated in the references, themselves.

For example, the Examiner states on page 6 that conventional polyurethane mixes only include waxes if they have releasing agents and "that polyurethane does not inherently include a wax." The Examiner is wrong. Appellant throughout prosecution has provided Appellant's position that typical polyurethanes include waxes. Therefore, Appellant respectfully disagrees with and traverses the Examiner's conclusion in this regard. If the position of the Examiner is to be maintained, evidence will have to be provided to support that position. For example, the Examiner would have to come forward with some documentation to support the notion that all polyurethanes typically do not include a wax (whether a release agent or not). The Examiner's position seems to be that if a reference does not explicitly state that a release agent is included with a polyurethane that somehow a wax would not be present. The Examiner's statement, if that is in fact what the Examiner means, is contrary to the well-known understanding of what a typical polyurethane includes.

On page 7, the Examiner implies that the *Harper* reference only teaches a wax as part of the releasing agent that is mentioned in that reference. *Harper* does not need to expressly state that the polyurethane otherwise includes a wax because they are already present in polyurethane mixes. *Harper's* only concern is with washing off any release agent that was applied to the mold during *Harper's* process. It is an improper use of the reference to extrapolate it and extend it beyond that context. It is important to consider *Harper's* teaching of an oil-free or wax-free surface as being limited to the absence of the release agent applied to the mold. *Harper* does not negate the presence of a wax in the polyurethane mix, itself.

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The Examiner appears to miss the point regarding the impossibility of making the proposed modifications to the *Wilcox* reference. For example, if *Wilcox's* jacket were made without any wax, that would be directly contrary to the express teachings of the reference as already pointed out by Appellant in its opening brief. The Examiner does not provide any response to that fact but, instead, points to *Harper's* release agent applied to the mold. Appellant's point is that if you remove the wax from the *Wilcox* reference entirely, which would be required to achieve a result consistent with Appellant's invention, then you would remove that intended, beneficial feature of the *Wilcox* arrangement. Such a modification is not permitted when attempting to manufacture a *prima facie* case of obviousness.

With regard to the "marking (coding) or painting of cables, such as for indicating their key materials of construction, operating capacities, inventory coding, etc." mentioned by the Examiner on page 7 of the Examiner's Answer, there is no suggestion anywhere within the art that an elevator rope assembly as recited in Appellant's claims or the rope of *Wilcox* would require such marking or painting. There is simply no indication other than hindsight reasoning to justify such an imagined reason for the proposed combination. Only when faced with the inapplicability of the *Harper* reference teachings to those of the *Wilcox* reference, does the Examiner imagine such a possibility. That indicates hindsight reasoning which is not permissible.

With regard to modifying *Wilcox* to include metallic load carrying members, the Examiner completely overlooks the fact that the *Wilcox* arrangement is intended to have a core of synthetic plastic filaments. That is a key feature of the rope in the *Wilcox* reference. If one were to remove the synthetic plastic filaments and replace them with metallic load carrying members, that would completely defeat the intended result of the *Wilcox* reference. Such a modification to a reference is not permissible and the Examiner's supposed justification for such a modification saying that it is

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for the purposes of "retention of strength...resistance to fire, for the benefits of performance and safety" ignores the fact that it goes directly contrary to the teachings of the *Wilcox* reference and prevents *Wilcox* from achieving its intended result (i.e., to have a rope with synthetic plastic filaments as the load carrying members).

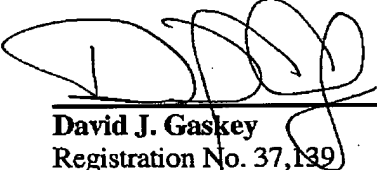
As the Examiner has failed to establish a *prima facie* case of obviousness, all rejections must be reversed.

Respectfully submitted,

CARLSON, GASKEY & OLDS, P.C.

June 2, 2008

Date


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CERTIFICATE OF FACSIMILE

I hereby certify that this Reply Brief, relative to Application Serial No. 09/921,803, is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571) 273-8300) on June 2, 2008.


Theresa M. Palmateer

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